

JAN. 25. 2005 4:57PM

BEST AVAILABLE COPY

NO. 0930 P. 1

HUNTON &
WILLIAMS

HUNTON & WILLIAMS LLP
1900 K STREET, N.W.
WASHINGTON, D.C. 20006-1109

TEL 202 • 955 • 1500
FAX 202 • 778 • 2201

TO NAME: S. Chunduru
FIRM: United States Patent and Trademark Office
FAX NO.: 571-273-8300
PHONE NO.: 571-272-0783
PAGES (INCLUDING COVER): 13
ORIGINAL TO FOLLOW IN MAIL: ☐ Yes ☒ No
FROM NAME: Jessica L. Parzzo
FLOOR: 11th
DIRECT DIAL: (202) 419-2110

MESSAGE

Re: Daniel DUPRET *et al.*
Serial No. 09/723,316
Filed: November 28, 2000

Title: METHOD FOR OBTAINING *IN VITRO* RECOMBINANT POLYNUCLEOTIDE
SEQUENCES, SEQUENCE BANKS AND RESULTING SEQUENCES

Attachments:

- (1) Resubmission of Previously filed Terminal Disclaimers to Obviate A Provisional Double Patenting Rejection Over a Pending Second Application
- (2) A copy of the January 12, 2005 PTO Date-Stamped Return Receipt Post card; a copy of a Terminal Disclaimer to Obviate a Provisional Double Patenting Rejection Over Pending Application No. 10/131,175 filed January 12, 2005; and a copy of check stub No. 2063395 in the amount of \$65.00
- (3) A copy of the January 7, 2005 PTO Date-Stamped Return Receipt Post card; a copy of a Terminal Disclaimer to Obviate a Provisional Double Patenting Rejection Over Pending Application No. 10/153,706 filed January 7, 2005; and a copy of check No. 2063360 in the amount of \$65.00
- (4) A copy of the January 7, 2005 PTO Date-Stamped Return Receipt Post card; a copy of a Terminal Disclaimer to Obviate a Provisional Double Patenting Rejection Over Pending Application No. 09/840,861 filed January 7, 2005; and a copy of check No. 2063361 in the amount of \$65.00.

IF PROBLEM WITH TRANSMISSION, PLEASE CONTACT OPERATOR AT
202 • 955 • 1500.

OPERATOR

DATE: January 25, 2005
TIME:
CLIENT/MATTER NAME: Proteus S.A.
CLIENT/MATTER NO.: 58763.000004

This communication is confidential and is intended to be privileged pursuant to the attorney-client privilege and the work-product doctrine. If the reader of this message is not the intended recipient, or the employee or agent responsible to deliver it to the intended recipient, you are hereby notified that any dissemination, distribution or copying of this communication is strictly prohibited. If you have received this communication in error, please immediately notify us by telephone, and return the original message to us at the above address via the U.S. Postal Service.

I hereby certify that this paper was faxed to the U.S. Patent and Trademark Office on the date indicated below.

Date January 25, 2005

Signature:

Carlester J. Holmer

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of :

Daniel DUPRET *et al.*

Examiner: S. Chunduru

Serial No.: 09/723,316

Group Art Unit: 1637

Filed: November 28, 2000

For: METHOD FOR OBTAINING *IN VITRO* RECOMBINANT POLYNUCLEOTIDE SEQUENCES, SEQUENCE BANKS AND RESULTING SEQUENCES**RESUBMISSION OF PREVIOUSLY-FILED TERMINAL DISCLAIMERS
TO OBTVIATE A PROVISIONAL DOUBLE PATENTING REJECTION OVER A
PENDING SECOND APPLICATION**

VIA FACSIMILE

MAIL STOP AMENDMENT

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Applicant hereby resubmits the following three (3) previously-filed Terminal Disclaimers
To Obviate A Provisional Double Patenting Rejection Over a Pending Second Application:

- 1.) Terminal Disclaimer To Obviate A Provisional Double Patenting Rejection Over Pending Application No. 09/840,861 (filed January 7, 2005);
- 2.) Terminal Disclaimer To Obviate A Provisional Double Patenting Rejection Over Pending Application No. 10/153,706 (filed January 7, 2005); and
- 3.) Terminal Disclaimer To Obviate A Provisional Double Patenting Rejection Over Pending Application No. 10/131,175 (filed January 12, 2005).

Although two (2) of the above-listed Terminal Disclaimers were filed on January 7, 2005 ("the two January 7th Terminal Disclaimers") and one (1) of the above-listed Terminal Disclaimers was filed on January 12, 2005 ("the January 12th Terminal Disclaimer"), Applicant's

PATENT

☐ PROVISIONAL
☒ UTILITY☐ DESIGN
☐ PCT

Application No.: 09/723,316

Date: January 12, 2005

Filing Date: November 28, 2000

Client/Matter No.: 58763.000004

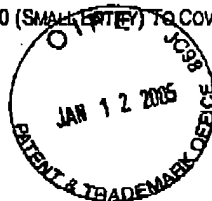
Client: Proteus S.A.

Inventor(s): Daniel DUPRET et al.

Atty/Sec.: JLP/cdh

Title: METHOD FOR OBTAINING IN VITRO RECOMBINANT POLYNUCLEOTIDE SEQUENCES,
SEQUENCE BANKS AND RESULTING SEQUENCESThe following has been received in the U.S. Patent and Trademark Office on the date stamped
thereon:

- ☒ TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING REJECTION OVER PENDING
APPLICATION NO. 10/131,175
- ☒ CHECK NO. 2063395 IN THE AMOUNT OF \$65.00 (SMALL ENTITY) TO COVER FEE
- ☒ RECEIPT POSTCARD (GREEN)



2063395 * 1/13/05

Attorney Docket No.: 58763.000004

**TERMINAL DISCLAIMER TO OBVIATE A PROVISIONAL DOUBLE
PATENTING REJECTION OVER A PENDING SECOND APPLICATION**

In re Application Of: **Daniel DUPRET et al.**
 Application Number: **09/723,316** Group Art Unit: **1637**
 Filed: **November 28, 2000** Examiner: **S. Chunduru**
 Title: **Method for Obtaining in vitro Recombinant Polynucleotide Sequences, Sequence Banks and Resulting Sequences**

The owner, **Proteus, S.A.**
 of **100** percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173 as shortened by any terminal disclaimer filed prior to the grant of any patent granted on pending second Application Number:

10/131,175 filed on: **April 25, 2002**

The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the second application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon grantee, its successors and assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of any patent granted on the second application, as shortened by any terminal disclaimer filed prior to the patent grant, in the event that any such granted patent: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. 1.321, has all claims cancelled by a reexamination certificate, is reissued, or in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.

Check either box 1 or 2, if appropriate.

1. ☐ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney of record.
 3. ☐ Owner/applicant is ☒ Small entity ☐ Large entity
 4. The terminal disclaimer fee under 37 C.F.R. 1.20(d) is **\$65.00** and is to be paid as follows:

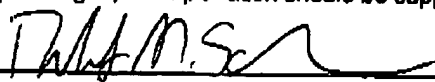
- ☒ A check in the amount of the fee is enclosed.
☒ The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. **50-0206**. A duplicate of this sheet is enclosed.

PTO suggested wording for terminal disclaimer was

- ☒ unchanged. ☐ changed (If changed, an explanation should be supplied).

January 12, 2005

Date



Signature

Robert M. Schulman, Reg. No. 31, 196

Typed or Printed Name

Attorney of Record

Title

HUNTON & WILLIAMS LLP

Company Name

1900 K Street, Suite 1200

Address

Washington, DC 20006

Address

JAN. 25. 2005 4:58PM

BEST AVAILABLE COPY

NO. 0980 P. 5

HUNTON
WILLIAMS

CHECK NO. 2063395

01/12/05	PT00112	58763	000004	STATUTORY DISCLAIMER APPLICATION NO. 10/131,175	65.00
					65.00

PLEASE DETACH AND RETAIN THIS PORTION FOR YOUR RECORDS

<input type="checkbox"/>	PROVISIONAL	PATENT	<input type="checkbox"/>	DESIGN
<input checked="" type="checkbox"/>	UTILITY		<input type="checkbox"/>	PCT
Application No.: 09/723,316		Date:	January 7, 2005	
Filing Date: November 28, 2000		Client:	Proteus S.A.	
Client/Matter No.: 58763.000004		Atty/Sec.:	JLP/cdh	
Inventor(s): Daniel DUPRET et al.				
Title: METHOD FOR OBTAINING IN VITRO RECOMBINANT POLYNUCLEOTIDE SEQUENCES, SEQUENCE BANKS AND RESULTING SEQUENCES				
The following has been received in the U.S. Patent and Trademark Office on the date stamped thereon:				
<input checked="" type="checkbox"/>	TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING REJECTION OVER PENDING APPLICATION NO. 10/153,706			
<input checked="" type="checkbox"/>	CHECK NO. 2063360 IN THE AMOUNT OF \$65.00 (SMALL ENTITY) TO COVER FEE			
<input checked="" type="checkbox"/>	RECEIPT POSTCARD (GREEN)			



JAN. 25. 2005 4:58PM

NO. 0980 P. 7

Attorney Docket No.: 58763.000004

**TERMINAL DISCLAIMER TO OBIVATE A PROVISIONAL DOUBLE
PATENTING REJECTION OVER A PENDING SECOND APPLICATION**

In re Application Of: **Daniel DUPRET et al.**
 Application Number: **09/723,316** Group Art Unit: **1637**
 Filed: **November 28, 2000** Examiner: **S. Chunduru**
 Title: **Method for Obtaining in vitro Recombinant Polynucleotide Sequences, Sequence Banks and Resulting Sequences**

The owner, **Proteus, S.A.**

of **100** percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173 as shortened by any terminal disclaimer filed prior to the grant of any patent granted on pending second Application Number:

10/153,706

filed on: **May 24, 2002**

The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the second application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon grantee, its successors and assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of any patent granted on the second application, as shortened by any terminal disclaimer filed prior to the patent grant, in the event that any such granted patent: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. 1.321, has all claims cancelled by a reexamination certificate, is reissued, or in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.

Check either box 1 or 2, if appropriate.

1. ☐ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney of record.
3. ☐ Owner/applicant is ☒ Small entity ☐ Large entity
4. The terminal disclaimer fee under 37 C.F.R. 1.20(d) is **\$65.00** and is to be paid as follows:
☒ A check in the amount of the fee is enclosed.
☒ The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. **50-0206**. A duplicate of this sheet is enclosed.

PTO suggested wording for terminal disclaimer was

- ☒ unchanged. ☐ changed (If changed, an explanation should be supplied).

January 7, 2005

Date

Robert M. Schulman
 Signature

Robert M. Schulman, Reg. No. 31, 196

Typed or Printed Name

Attorney of Record

Title

HUNTON & WILLIAMS LLP

Company Name

1900 K Street, Suite 1200

Address

Washington, DC 20006

Address

JAN. 25. 2005 4:59PM

BEST AVAILABLE COPY

NO. 0980 2. 9

☐ PROVISIONAL
☒ UTILITY

PATENT

☐ DESIGN
☐ PCT

Application No.: 09/723,316
Filing Date: November 28, 2000
Client/Matter No.: 58763.000004
Inventor(s): Daniel DUPRET et al.
Title: METHOD FOR OBTAINING IN VITRO RECOMBINANT POLYNUCLEOTIDE SEQUENCES,
SEQUENCE BANKS AND RESULTING SEQUENCES

Date: January 7, 2005
Client: Proteus S.A.
Atty/Sec.: JLP/cdh

The following has been received in the U.S. Patent and Trademark Office on the date stamped thereon:

☒ TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING REJECTION OVER PENDING APPLICATION NO. 09/840,861
☒ CHECK NO. 206316 IN THE AMOUNT OF \$65.00 (SMALL ENTITY) TO COVER FEE
☒ RECEIPT POSTCARD (GREEN)



RECEIVED 1/10/05

**TERMINAL DISCLAIMER TO OBVIATE A PROVISIONAL DOUBLE
PATENTING REJECTION OVER A PENDING SECOND APPLICATION**

In re Application Of: **Daniel DUPRET et al.**
 Application Number: **09/723,316** Group Art Unit: **1637**
 Filed: **November 28, 2000** Examiner: **S. Chunduru**
 Title: **Method for Obtaining in vitro Recombinant Polynucleotide Sequences, Sequence Banks and Resulting Sequences**

The owner, **Proteus, S.A.**
 of **100** percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173 as shortened by any terminal disclaimer filed prior to the grant of any patent granted on pending second Application Number:

09/840,861 filed on: **April 25, 2001**

The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the second application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon grantee, its successors and assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of any patent granted on the second application, as shortened by any terminal disclaimer filed prior to the patent grant, in the event that any such granted patent: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. 1.321, has all claims cancelled by a reexamination certificate, is reissued, or in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.

Check either box 1 or 2, if appropriate.

1. ☐ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

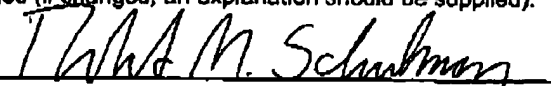
2. ☒ The undersigned is an attorney of record.
 3. ☐ Owner/applicant is ☒ Small entity ☐ Large entity
 4. The terminal disclaimer fee under 37 C.F.R. 1.20(d) is **\$65.00** and is to be paid as follows:
☒ A check in the amount of the fee is enclosed.
☒ The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. **50-0206**. A duplicate of this sheet is enclosed.

PTO suggested wording for terminal disclaimer was

- ☒ unchanged. ☐ changed (if changed, an explanation should be supplied).

January 7, 2005

Date


 Signature

Robert M. Schulman, Reg. No. 31, 196

Typed or Printed Name

Attorney of Record

Title

HUNTON & WILLIAMS LLP

Company Name

1900 K Street, Suite 1200

Address

Washington, DC 20006

Address

PAGE 11/11 * RCVD AT 1/25/2005 4:51:39 PM [Eastern Standard Time] * SVR:USPTO-EFXRF-1/25 * DNIS:2738300 * CSID: * DURATION (mm-ss):03-14